

Serial No. 09/939,883  
Filed: August 27, 2001

### REMARKS

Applicants provisionally elect the subject matter of Group I, i.e., claims 1-6, 8-38, 48-78, 82-86 and 92-96, directed to compounds of formula I and Ia wherein:

A<sup>1</sup> is CH, and

A<sup>2</sup> is pyrrolidine; piperidine, or 3,4-dihydro-1H-isoquinoline, or azepane;

or R<sup>8</sup> is a bond or lower alkyl.

Applicants also provisionally elect the species of Example 1.2.

Applicants traverse the requirement for restriction.

The U.S. Patent Office is required to examine on the merits the entirety of generic claims. As set forth in MPEP § 809.02, the U.S. Patent Office is required to perform a search for all claims readable on the elected species. If the elected species is found patentable, then subsequent species should be examined. If no species is found unpatentable, then the generic claim should be allowed. The MPEP does not authorize the Patent Office to derive its own concept of a genus from claim 1 and require that it be carved out of existing claims.

Applicants point out that it is well-established law that restriction within a single claim cannot be sustained under 35 U.S.C. §121. As is stated in *In re Weber*, 198 USPQ 328 (CCPA 1978), at pages 331-332:

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“§121 provides the Commissioner with the authority to promulgate rules designed to *restrict an application* to one of several claimed inventions when those inventions are found to be “independent and distinct.” It is not, however, provide a basis for the Examiner acting under the authority of the Commissioner to *reject* a particular *claim* on that same basis.” (Emphasis in original text.)

If the Patent Office were to withdraw applicants’ claims in part from further consideration due to an intraclaim restriction, the requirement amounts in fact to a rejection, see *In re Hass*, 179 USPQ 623, 625 (CCPA 1973).

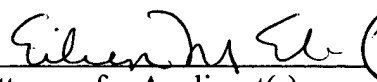
Applicants have the right under U.S. patent law to claim their invention using the limitations that they provide to delineate the invention, as long as the requirements of 35 U.S.C. §112 are met. See *In re Weber* at 331 and *In re Wolfrum and Gold*, 179 USPQ 620, 622 (CCPA 1973).

Applicants request that the restriction requirement be withdrawn. In particular, Applicants request that the intra-claim restriction requirements be withdrawn since such restriction is prohibited both under the law and under Patent Office policy as set forth in the MPEP.

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As the period set for reply was three months from the mailing date of the Action, it is believed that no fee is due. If a fee is owing, however, please charge our Deposit Account No. 08-2525.

Respectfully submitted,

  
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Attorney for Applicant(s)  
Eileen M. Ebel  
(Reg. No. 37316)  
340 Kingsland Street  
Nutley, New Jersey 07110  
Telephone: (973) 235-4391  
Telefax: (973) 235-2363

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